



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/942,061

08/29/01

HU

B

CFP-1080CA

ALAN D. KAMRATH  
RIDER, BENNETT, EGAN & ARUNDEL, LLP  
SUITE 2000  
333 SOUTH SEVENTH STREET  
MINNEAPOLIS MN 55402

QM32/1018

EXAMINER

SHAKERI, H

ART UNIT

PAPER NUMBER

3723

4

DATE MAILED:

10/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/942,061

Applicant(s)

HU, BOBBY

Examiner

Hadi Shakeri

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-25 and 40-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-25 and 40-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/541,193 (6,282,992).
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 04.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8/29/01 has been approved.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 21-25, 40, and 41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claims 21-25, 40 and 41, "...a switch member...rotatably received in the head..." as claimed in line 8, claim 21 was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention. The switch, per specification is received in the handle and not the head.

Regarding claims 44-49, a ratcheting tool handle with an end wall having outer surface, which is contiguous with the first face of the head, as claimed in line 2, claim 44 was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Specification as originally filed supports the embodiment in which the outer face is contiguous with the second face but is insufficient to support the embodiment in which the outer face is contiguous with the first face.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 42-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 41, "axially" is vague and indefinite.

Regarding claim 42, "A handle for a ratcheting tool comprising in combination:" as claimed in line 1, makes the claim vague and indefinite. It is not clear what combination is being claimed. A handle in combination with a ratcheting tool or in combination with a head? The claim language as written is vague and indefinite.

Further regarding claim 42 "the second end wall section" as claimed in line 10, lacks sufficient antecedent basis. Applicant may wish to amend the "first and second wall section" recited in line 5, to --first and second end wall sections--.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

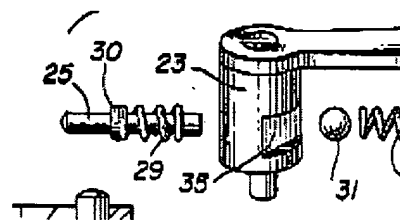
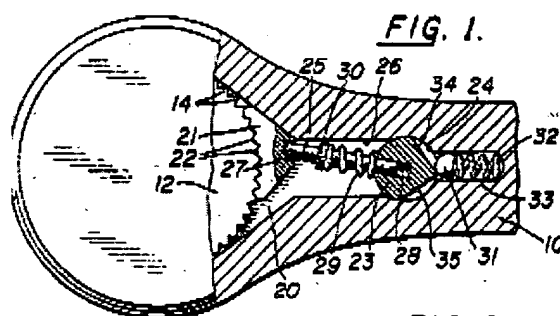
A person shall be entitled to a patent unless –

Art Unit: 3723

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 21, 23, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Kilness, US Patent No. 3,265,171.

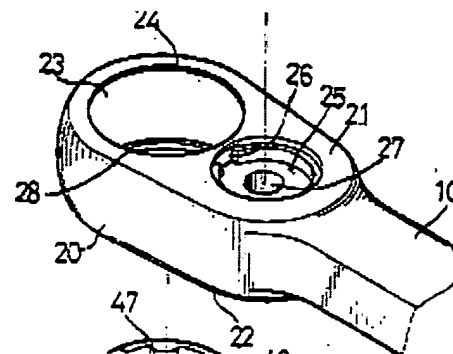
Kilness discloses all the limitations of claim 21, i.e., a drive member including a plurality of teeth, a pawl (21) including a first side with teeth (22) and a second side with a recess (27), a switch member including a turn piece (36), an actuating plate (23) with a first receptacle (28), an elastic element (29), a peg (25) with a first end received in the pawl and a second end received in the first receptacle and including a second receptacle (receiving the spring) with a second end wall (30), with the elastic member located between the first end wall and the second end wall.



Regarding claims 23 and 41, Prior Art (PA) meets the limitations.

8. Claims 42-49, 52 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Chow, US Patent No. 5,533,427.

Chow meets all the limitations of claim 42, i.e., a hole (23), a cavity (26) communicating with the hole, a compartment (25) spaced from a first face, and a bridge.



Regarding claim 43, PA meets the limitations, i.e., end wall (24) defining an opening.

Regarding claims 44-49, 52 and 53, PA meets the limitations.

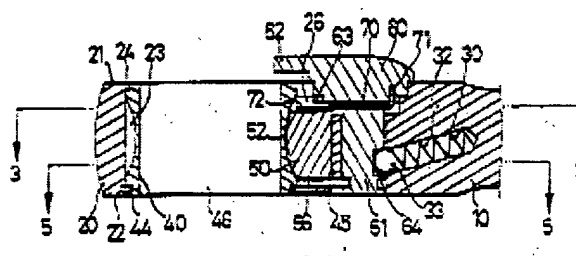
### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

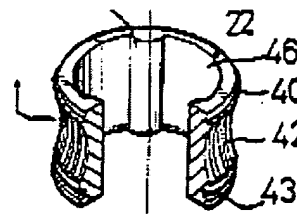
10. Claims 22, 25, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilness in view of Chow.

Kilness as described above meets all the limitations of claim 22, except for the drive member to be a gear wheel. Chow teaches a ratchet wrench with a gear wheel. It would have been



obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Kilness with a gear wheel as taught by Chow to adapt the tool ~~for~~ with a gear wheel for engaging with like fasteners.

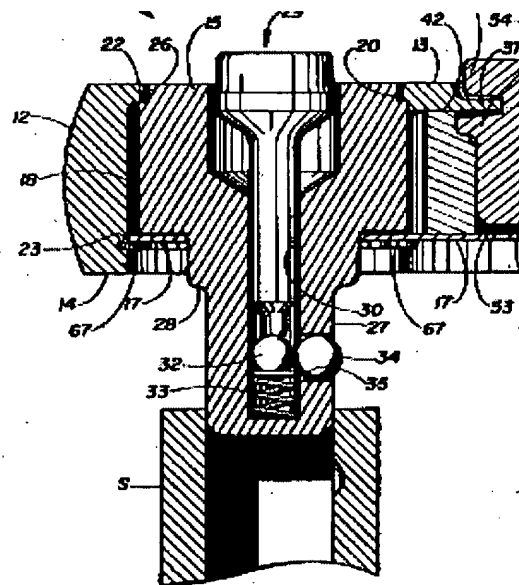
Regarding claim 25, PA meets the limitations, i.e., first annular groove (28), a second annular groove (43), and a C-clip (44).



Regarding claim 40, PA meets the limitations, i.e., second annular groove (43), spaced from top and bottom.

11. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kilness in view of Arnold et al., US Patent No. 5,178,047.

Kilness as described above meets all the limitations of claim 24, except for the end wall and the stub. Arnold et al. teaches a ratchet wrench with a head having an end wall (26) and a drive member with a stub (29). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Kilness with a drive member with a column as taught by Arnold et al. to adapt the tool for engaging with like fasteners having quick release mechanism.



12. Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Arnold et al.

Chow as described above meets all the limitations of the above claims, except for the column drive member and the stub. Arnold et al. teaches a ratchet wrench with a head having an end wall (26) and a drive member with a stub (29). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Chow with a drive member with a column as taught by Arnold et al. to adapt the tool for engaging with like fasteners having quick release mechanism.

***Double Patenting***

**13.** The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**14.** Claims 21-25, 40-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 4, 27, 34-37 of U.S. Patent No. 6,282,992. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed, i.e., a peg having a receptacle and a head as shown in Figs. 2 and 7 is fully disclosed in the above mentioned US Patent, Figs. 2 and 9.

**15.** Claims 42-53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No.



6,282,991. Although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed, i.e., a head as shown in Figs. 2 and 7 is fully disclosed in the above mentioned US Patent, Figs. 2, 7 and 9.

**16.** Claims 21-25 and 40-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,282,991 in view of Fosella and Kress. The above-mentioned US Patent discloses all the limitations except for a peg with a receptacle. Fosella, Figs. 3 and 5 discloses a switch member actuating the pawl with a spring-loaded plunger 130, thus spring loaded peg as further illustrated by Kress, Figs. 1 and 2., is old and an obvious modification in view of prior art.

**17.** Claims 21-25, 40-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 09/814,430 in view of McCann. Because subject matter claimed, i.e., a peg having a second receptacle and a head as shown in Figs. 2 and 7 is disclosed in the above mentioned US application, Figs. 2, 7 and 9. A peg having a second receptacle with a second end wall (annular shoulder) as disclosed in Fig. 7 and a drive column in Fig. 9, PA, as obvious modifications. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member.

As indicated in the cited reference McCann, Figs. 1 and 2, these limitations and embodiment are old and obvious modifications.

This is a provisional obviousness-type double patenting rejection.

**18.** Claims 21-25, 40-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/923,120 in view of McCann and Chen. Because subject matter claimed, excluding the head as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Figs. 1, 2, 9 and 10. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old and obvious modifications.

This is a provisional obviousness-type double patenting rejection.

**19.** Claims 21-25, 40-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of copending Application No. 09/854,795 in view of Fosella, Kress, McCann and Chen. Because subject matter claimed, i.e., the pawl, switch member, and elastic member are disclosed in the above-mentioned US application, Figs. 1, 2, 9 and 10, except for a peg having a second receptacle with a second end wall, a head with an opening and the drive column. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular

Art Unit: 3723

shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old and obvious modifications. Regarding the peg with the receptacle Fosella, Figs. 3 and 5 discloses a switch member actuating the pawl with a spring-loaded plunger 130, thus spring loaded peg as further illustrated by Kress, Figs. 1 and 2., is old and an obvious modification in view of prior art.

This is a provisional obviousness-type double patenting rejection.

**20.** Claims 21-25, 40-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/888,810 in view of McCann and Chen. Because subject matter claimed, i.e., as shown in Figs. 2 and 7 is disclosed in the above-mentioned US application, Fig. 6. Regarding the head, the Application discloses all the limitations except for an end wall defining the opening having a smaller diameter being received in an annular shoulder of the drive member and a drive column with a stub. As indicated in the cited references McCann, Figs. 1 and 2, and Chen, Figs. 1 and 2, these limitations and embodiment are old and obvious modifications.

This is a provisional obviousness-type double patenting rejection.

### ***Conclusion***

**21.** Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279

Application/Control Number: 09/942,061

Page 11

Art Unit: 3723

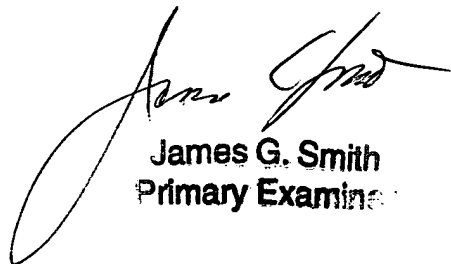
for unofficial documents. The examiner can normally be reached on Monday-Thursday,  
7:30 AM to 6:00 PM.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist at (703) 308-1148.

HS



October 9, 2001



James G. Smith  
Primary Examiner